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REMARKS

Claims 1 - 49 are pending in the present Application. Claims 1 and 4 have been amended, and claims 26 - 49 have been withdrawn, leaving Claims 1 - 25 for consideration upon entry of the present Amendment. Claims 26 - 49 have been withdrawn as a result of a restriction requirement based on a telephonic conversation with the Examiner on June 2, 2005. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1 - 3, 9 - 16 and 25 stands rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by U.S. Patent No. 6,258,182 to Schetky et al. (Schetky). Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Claim 1 as presently amended is directed to an alloy composition comprising titanium; and a molybdenum equivalent weight of about 7 to about 11 wt%, wherein the weight percents are based upon the total weight of the alloy composition, wherein the alloy composition is superelastic and/or pseudoelastic, wherein the composition is devoid of niobium.

Schetky et al. disclose a substantially nickel-free beta phase titanium alloy comprising between 10.0-12.0 wt% Mo, 2.8-4.0 wt% Al, 0.0-2.0 wt% Cr and V, 0.0-4.0 wt % Nb, with the balance being titanium. (see Abstract))

It is to be noted that when the composition of Schetky does not contain niobium, it does not meet the limitations of Claim 1 as presently amended, i.e., it does not meet the limitations of a molybdenum equivalent of 7 to 11 wt% as presently claimed.

On the other hand, when the Schetky composition does contain niobium, it does not meet the limitations of Claim 1, since Claim 1 is directed to a composition that is devoid of niobium. For these reasons at least, Schetky cannot anticipate the claimed invention.

Applicants therefore respectfully request a withdrawal of the § 102 (b) rejection and an allowance of the claims.

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Claim Rejections Under 35 U.S.C. § 103(a)

Claims 4 – 8, 17 – 23, and 25 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over Schetky. (Office Action dated 06/15/2005, page 7) Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 4 as presently amended is directed to a composition that comprises about 8 to about 9.75 wt% molybdenum. Schetky, on the other hand, teaches a composition that comprises 10 to 12 wt% molybdenum. Schetky therefore does not teach all elements of the claimed invention.

In addition, there is no motivation for one of ordinary skill in the art to modify Schetky to arrive at the claimed invention. In the first instance, Schetky teaches away from the claimed invention. Table III of Schetky (which contains the alloys cited by the Examiner), in fact, teaches away from compositions having a molybdenum content of less than 10 wt%. Table III discloses alloys #27 and #36 comprising 9.5 wt% and 8.4 wt% Mo, respectively, but these alloys failed to display either pseudo-elastic strain recovery or shape memory strain recovery. Alloy #28 also fails to display any shape memory effect. A person of ordinary skill in the art upon reading this disclosure and discovering that compositions having less than 10.0 wt% molybdenum fail to exhibit significant pseudo-elastic strain recovery, would not be motivated to modify Schetky to reduce the amount of molybdenum.

Since Schetky does not teach all elements of the claimed invention and since there is no motivation to modify Schetky, Applicants believe that the Examiner has not made a *prima*

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facie case of obviousness over Schetky. Applicants respectfully request a withdrawal of the § 103 (a) rejection and an allowance of the claims.

Double Patenting Rejections

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-52 of copending Application No. 10/609,004. (Office Action dated June 15, 2005, page 9).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-49 of copending Application No. 10/609,003. (Office Action dated June 15, 2005, page 10).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 15-24 of copending Application No. 10/869,359. (Office Action dated June 15, 2005, page 9).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of copending Application No. 10/755,085. (Office Action dated June 15, 2005, page 10).

Applicant respectfully requests that the examiner withdraw the "provisional" obviousness-type double patenting rejections until the claims are in final form and condition for allowance; until such time, there is no double patenting and no way to determine double patenting. MPEP § 804.01.I(B)(1).


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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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